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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,468	07/01/2003	Manabu Kodate	059695-0102	1060

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EXAMINER	
PIZIALI, JEFFREY J	

ART UNIT	PAPER NUMBER
2629	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/609,468	KODATE ET AL.	
	Examiner	Art Unit	
	Jeff Piziali	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-22* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 February 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings were received on 10 February 2006. These drawings are acceptable.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, 13-18, 21, and 22, drawn to an image display element having a particular distance between a first wire and a second wire, classified in class 345, subclass 90 (i.e. control means at each display element).

II. Claims 9-12, 19, and 20, drawn to an image display element having a particular distance between a wire and a substrate, classified in class 345, subclass 206 (i.e. substrates for display elements and control devices).

The inventions are distinct, each from the other because of the following reasons:

4. **Inventions I and II** are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use

together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

In the instant case, the inventions as claimed do not overlap in scope (i.e., are mutually exclusive), insofar as Invention I features claimed first-wire-to-second-wire distance subject matter that is nonexistent in Invention II. Moreover, Invention II features claimed wire-to-substrate distance subject matter that is nonexistent in Invention I.

The inventions as claimed are not obvious variants, insofar as an image display element having any particular distance between a first wire and a second wire might still realize a distance between a wire and a substrate less than 5μm. Furthermore, an image display element having a distance between a wire and a substrate of at least 5μm might still realize a distance between a first wire and a second wire different from that of Invention I.

The inventions as claimed have a materially different design, mode of operation, function, and effect, insofar as Invention I is drawn to realizing a particular distance between a first wire and a second wire, while Invention II is drawn to realizing a particular distance between a wire and a substrate.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Although the aforementioned divergent subject matter was more or less intact at the time of the previous office action (mailed 11 August 2005), the applicants' claim amendments and ensuing remarks filed 10 February 2006 have persuaded

the examiner that independent/distinct inventions are definitely being claimed, which if left unchecked would result in a serious examination burden henceforth.

6. The application further contains claims directed to the following three patentably distinct species:

Species I, drawn to an image display element having no insulation covering surface wires [Fig. 5; 10 & 31] (see Page 12, Line 6 - Page 13, Line 7 of the instant specification);

Species II, drawn to an image display element using a pillar-shaped spacer type insulator [Fig. 7; 35] (see Page 17, Line 11 - Page 18, Line 23 of the instant specification); and

Species III, drawn to an image display element using a light-shield film (aka "black matrix") type insulator [Figs. 8 & 9D; 42] (see Page 18, Line 24 - Page 20, Line 20 of the instant specification).

The species are independent or distinct because they do not overlap in scope (i.e., are mutually exclusive inventive embodiment alternatives of one another). Each species would require a unique search strategy for the corresponding divergent subject matter, resulting in a burdensome examination. Although the aforementioned divergent subject matter was more or less intact at the time of the previous office action (mailed 11 August 2005), the applicants' claim amendments and ensuing remarks filed 10 February 2006 have persuaded the examiner that independent/distinct species are definitely being claimed, which if left unchecked would result in a serious examination burden henceforth.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 and 13-15 appear to be generic.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. A telephone call was made to Mr. Glenn Law (Registration Number 34,371) on 19 April 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants are advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicants traverse on the ground that the inventions or species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The applicants are hereby notified that the examiner's art unit has recently changed from Art Unit 2673 to Art Unit 2629, please direct all future correspondence accordingly. Thank you.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.P.
19 April 2006